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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/443,401	11/19/1999	SAID ZAMANI-KORD	10991745-1	7179

22879 7590 04/24/2003

HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

DICUS, TAMRA

ART UNIT PAPER NUMBER

1774

DATE MAILED: 04/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/443,401

Applicant(s)

ZAMANI-KORD ET AL.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-33 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-33 and 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

All rejections are withdrawn. Cancellation of claims 3, 5, and 34 are acknowledged.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 4 recites the limitation "the... absorptive layer" in line 2. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what "includes a reflective sandwiched between" means.

Specification

5. The attempt to incorporate subject matter into this application by reference to an unlisted serial number and filing date is improper because this information is not filled in the blanks. See page 1.

Claim Objections

6. Claims 17-22 are objected to as it is unclear what "interference preventing means" means.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-2, are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,089,614 to Howland et al.

9. Howland teaches a security device with first (7) and second (8) indicia with a metallized substrate in the middle (1). The indicia are printed with conventional inks such as fluorescing inks. See col. 8, lines 12-20. At col. 3, lines 7-20, Howland teaches the indicia may be machine readable on each side of the substrate. The substrate can be coated with a very thin film of aluminium (equivalent to thin metal foil layer of claim 2), metal oxide or other reflective layer at col. 3, lines 23-33. That the structure has a means for preventing interference is inherent as the same layered structure and materials are provided by Howland.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 4, 6, 7-12-28, 32-33, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,417,247 to Hardwick et al. in view of USPN 6,089,614 to Howland et al. and USPN 5,492,370 to Chatwin et al.

12. Hardwick teaches banknotes incorporating security devices that comprise a planar substrate (10) (claim 32) having a first and second indicia surrounding the first and second surfaces of substrate (10), see Figure 6. The inks to print the indicia may be of titania or fluorescent type, see col. 4, lines 30-35. Hardwick teaches two individual ink layers above and below the substrate (first and second thin layers of a substrate material of claim 8). Hardwick is silent to teaching a foil or reflective layer between the two indicia. However Howland teaches a security device with first (7) and second (8) indicia with a metallized substrate in the middle (1). The substrate can be coated with a very thin film of aluminium (equivalent to thin metal foil layer of claim 2), metal oxide or other reflective layer at col. 3, lines 23-33. Hence it would have been obvious to one of ordinary skill in the art to modify the banknote of Hardwick to include a metallized, foil, or reflective layer as the substrate since Howland teaches metallizing a substrate to exhibit such properties as high reflectivity and also enable the second indicia to be viewed in transmitted light at col. 3, lines 29-33.

Hardwick is silent to stating the specific polymer used in the plastic substrate (claim 9). However, Chatwin teaches a decorative article that comprises a plastic metallized substrate of polyester at col. 6, lines 20-25. Hence it would have been obvious to one of ordinary skill in the art to modify the banknote of Hardwick to include polyester since it is well known functional equivalent polymeric film as Chatwin teaches at col. 6, lines 20-30.

Hardwick is silent to teaching the specific metal oxide used in the reflective layer. However, Chatwin teaches well known metal oxides such as titania (radiation blocking-claim 7) at col. 8, lines 5-9. Hence it would have been obvious to one of ordinary skill in the art to modify the banknote of Hardwick to include a metal oxide such as titania since it is a suitable functional equivalent as taught by Chatwin at col. 8, lines 1-9.

The property of the fluorescent material of claim 10 is inherent as the same materials are used as Hardwick.

Regarding claim 11, since the same position of the indicia is taught, the indicia is in overlapping relation.

Hardwick does not teach further comprising a print medium, tape having first and second surface (tape layer), or roll of claims 12-28, and 35-37. However, Chatwin teaches several print medias such as a glass or tax certificate adhered to the substrate via a self adhesive film/layer (tape) at col. 11, lines 50-65 and col. 12, lines 1-25. Hence it would have been obvious to one of ordinary skill in the art to modify the banknote of Hardwick to further include a print medium and tape layer for the purpose of producing vehicle tax certificates as taught by Chatwin at col. 11, lines 50-65 and col. 12, lines 1-25.

Chatwin teaches at col. 6, line 39, the substrate may be in roll form (claims 14 and 31). Hence it would have been obvious to one of ordinary skill in the art to modify the banknote of Hardwick to include a substrate in roll form since Chatwin teaches a substrate can be in roll form to be cut and sized at col. 6, lines 40-43.

While Hardwick does not define the structure of claims 12-28 and 35-37, Chatwin teaches indicia may be coated on one or both sides of the polymeric substrate at col. 5, lines 45-

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58. Tape is a polymeric substrate and hence it is obvious to include a reflective material disposed on either side since the references teach metallizing, or providing metal oxide or reflective coatings to a plastic film is known to provide optical variable effects as taught by Chatwin at col. 5, lines 34-40, col. 6, lines 28-33.

Response to Arguments

13. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. Chatwin is used to teach it is known to metallize a polymeric film, roll, web, and included to teach a printed media of translucent appearance is known.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

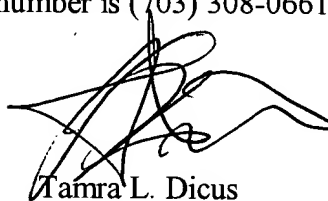
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tamra L. Dicus
Examiner
Art Unit 1774

April 21, 2003

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

